REMARKS

Reconsideration of the above-identified patent application in view of the amendments above and the remarks following is respectfully requested.

Claims 19, 22-28, 36 and 37 are in this case. Claims 19 and 22-28 have been rejected under the judicially created doctrine of obviousness-type double patenting. Claims 22, 23 and 28 have been rejected under § 112, second paragraph. Claims 19, 22-28, 36 and 37 have been rejected under § 103(a). Claim 25 has been objected to. Independent claim 28 has been canceled. Independent claims 22 and 25 and dependent claim 23 have been amended.

The claims before the Examiner are directed toward flash-based units for providing boot code to be executed by external processors and toward related systems and methods. Boot code, including code for basic initialization of the system and a command for loading more boot code, is stored in a flash memory that cannot be directly executed. The basic initialization code is transferred to a volatile memory component for execution by a processor to boot the system. The volatile memory component is only large enough to store the basic initialization code.

Double Patenting Rejections

The Examiner has rejected claims 19 and 22-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of co-pending US Patent Application No. 10/888,012. The Examiner's rejection is respectfully traversed.

Claim 28 has been canceled, thereby rendering moot the Examiner's rejection of these claims.

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Attached please find a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer, of any patent granted on pending second Application Number 10/888,012, filed on July 12, 2004.

§ 112, Second Paragraph Rejections

The Examiner has rejected claims 22, 23 and 28 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner has pointed out that the phrase "the code" in claims 22 and 23 lacks sufficient antecedent basis, that the phrase "a second portion" in claim 23 lacks sufficient antecedent basis, and that "the flash memory being of a type such that the external processor cannot read boot code to be executed directly from said flash memory" in claim 28 is unclear.

Claim 28 now has been canceled, thereby rendering moot the Examiner's rejection of this claim.

In claims 22 and 23, "the code" has been amended to "the boot code". Implicit support for these amendments is found in the specification on page 10 lines 15-18:

> S-RAM **40** is optionally very small, such that the copied code is preferably only sufficient for permitting the basic initialization of system **30**, and more preferably enables the remaining portion of the code to be copied to RAM **34** at a later point...

All the code in this citation is boot code because the subject of the paragraph starting on page 10 line 7, from which this citation is taken, is "'booting' system **30**" (page 10 line 9). Further support for these amendments is found at the end of claim 23

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(misnumbered as "claim 24") as filed, "copying said second portion of the code for

booting the system", which implies that the second portion of the code is boot code.

In claim 23, "a second portion" has been amended to "said second portion" to

show that the "second" portion that is recited in claim 23 as being transferred to the

volatile memory is the same second portion that is recited in claim 22 as being the

subject of a copy command in the first portion of the boot code. Implicit support for

this amendment is found in the specification in the above citation from page 10 lines

15-18 combined with page 10 line 21 through page 11 line 1:

> CPU **32** begins execution of the code in stage 4 for booting.
> Optionally, additional code is copied from the flash memory **14** to
> RAM **34** for execution as necessary...

This "additional code" is the "remaining portion of the code" whose copying to RAM

34 is enabled by the code copied to S-RAM **40** in stage 2 of Figure 2.

§ 103(a) Rejections – Gefen et al. '702 in view of AAPA

§ 103(a) Rejections – Gefen et al. '702 in view of AAPA and Gibson et al. '167

The Examiner has rejected claims 19, 24-27 and 36 under § 103(a) as being

unpatentable over Gefen et al., US Patent Application Publication No. 2002/0138702

(henceforth, "Gefen et al. '702") in view of Applicant's Admitted Prior Art

(henceforth, "AAPA"). The Examiner has rejected claims 28 and 37 under § 103(a)

as being unpatentable over Gefen et al. '702 in view of AAPA and further in view of

Gibson et al., US Patent No. 6,601,167 (henceforth, "Gibson et al. '167"). The

Examiner has rejected claims 22 and 23 under § 103(a) as being unpatentable over

Gefen et al. '702 in view of AAPA with Gibson et al. '167 incorporated a an

evidentiary reference. The Examiner's rejection is respectfully traversed.

Claim 28 has been canceled, thereby rendering moot the Examiner's rejection

of this claim.

With regard to the other claims, according to § 103(c) it is improper for the Examiner to cite Gefen et al. '702 against these claims under § 103(a). § 103(c) states:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.
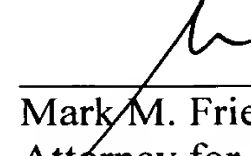
Gefen et al. '702 was filed on March 26, 2001 and not published until September 26, 2002. The above-identified patent application was filed on August 6, 2001. Therefore, Gefen et al. '702 is prior art against the above-identified patent application only under § 102(e). Attached please find a copy of an assignment of Gefen et al. '702 to M-Systems Flash Disk Pioneers Ltd. At the time of the filing of the above-identified patent application, the inventor, Dov Moran, was the Chief Executive Officer of M-Systems Flash Disk Pioneers Ltd. and as such was subject to an obligation of assignment to M-Systems Flash Disk Pioneers Ltd. Therefore, § 103(c) prohibits citing Gefen et al. '702 against the claims of the above-identified patent application under § 103(a).

Objections

The Examiner has objected to claim 25 for reciting the acronym "CPU" without an accompanying definition. Such a definition now has been supplied.

In view of the above amendments and remarks it is respectfully submitted that independent claims 19, 22 and 24-27, and hence dependent claims 23, 36 and 37 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

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